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REMARKS

Claims 1-25 remain in the application for consideration. In view of the following remarks amendments and/or remarks, Applicant respectfully requests that the application be forwarded onto issuance.

The Claim Rejections

Claims 1-25 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,744,472 to MacInnis in view of U.S. Patent No. 6,414,996 to Owen.

Before undertaking a discussion of the substance of the Office's rejections, the following discussion of the §103 Standard is provided.

The §103 Standard

To establish a prima facie case of obviousness, three basic criteria *must* be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Hence, when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of

1 whether there is a teaching, motivation, or suggestion to select and combine the
2 references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin*
3 *Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)
4 ("the central question is whether there is reason to combine [the] references," a
5 question of fact drawing on the Graham factors).

6 "The factual inquiry whether to combine references must be thorough and
7 searching." *Id.* It must be based on objective evidence of record. This precedent
8 has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g.,
9 *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-
10 25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion,
11 teaching, or motivation to combine the prior art references is an 'essential
12 component of an obviousness holding'" (quoting *C.R. Bard, Inc. v. M3 Systems,*
13 *Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re*
14 *Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our
15 case law makes clear that the best defense against the subtle but powerful
16 attraction of a hindsight-based obviousness analysis is rigorous application of the
17 requirement for a showing of the teaching or motivation to combine prior art
18 references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.
19 Cir. 1998) (there must be some motivation, suggestion, or teaching of the
20 desirability of making the specific combination that was made by the applicant); *In*
21 *re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings
22 of references can be combined only if there is some suggestion or incentive to do
23 so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*,
24 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).
25

1 The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217
2 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings
3 must be made as to the reason the skilled artisan, with no knowledge of the
4 claimed invention, would have selected these components for combination in the
5 manner claimed").

6 To support the conclusion that the claimed invention is directed to obvious
7 subject matter, either the references must expressly or impliedly suggest the
8 claimed invention or the examiner must present a convincing line of reasoning as
9 to why the artisan would have found the claimed invention to have been obvious
10 in light of the teachings of the references. See, e.g. *Ex parte Clapp*, 227 USPQ
11 972, 973 (Bd. Pat. App. & Inter. 1985).

12 13 The Claims

14 **Claim 1** recites a method comprising:

- 15
- 16 • receiving a command from a decoder application at an application
17 program interface (API); and
 - 18 • generating one or more filter control command data structures,
19 recognizable by a communicatively coupled accelerator including
20 one or more parameters which, when received by the accelerator,
21 affects one or more filter settings of the accelerator based, at least in
22 part, on the content of the received command.

23 In making out the rejection of this claim, the Office essentially argues that
24 MacInnis discloses all of the subject matter of this claim except for an application
25 program interface, citing to MacInnis's column 1, lines 41-43 and column 57,
lines 21-37 for support. The Office then argues that Owen teaches that it is well
known in the art to include an application program interface with decoder and

1 accelerator systems. Based on this, the Office reasons that it would be obvious to
2 take the apparatus disclosed by MacInnis and implement an application program
3 interface as taught by Owen in order to obtain an apparatus that can operate
4 efficiently.

5 Applicant disagrees with the substance and rationale used by the Office and
6 traverses the rejection. Applicant respectfully submits that the Office has not
7 made *particular findings* as to the reason the claimed subject matter would be
8 obvious in view of the cited references. Simply stating that the combination
9 would "obtain an apparatus that can operate efficiently" does not rise to the level
10 of a particular finding.

11 Additionally, and as an aside, the Office has provided a paper, available at
12 the following link:

13 <http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm>
14

15 that describes proper and improper rejections made under §103(a).
16 Particularly instructive is Example 17 which appears in Section V of the paper
17 illustrating an improper §103(a) rejection which is based upon hindsight in view of
18 a general motivation statement. This example is reproduced below in its entirety
19 for the Office's convenience:
20

21 V. Examples of Improper Rejection under 35 U.S.C. 103

22 Example 17: Improper rejection based upon hindsight - general 23 motivation statement.

24 a. The claimed invention 25

1 The invention is drawn to a smart card containing a tracking
2 mechanism, which tracks shopping preferences of consumers by recording
3 the type, quantity, and dates of purchase for a pre-selected group of
4 products. The smart card is useful in a system and method for introducing
5 new and alternative products that are of the same type as products normally
6 purchased by the shopper. The smart card records the shopper's purchases
7 and submits an automatic notification to the shopper when a quantity
8 threshold is achieved for the pre-selected products. This notification will
9 encourage the consumer to consider alternative products by providing the
10 consumer incentives, such as a pricing discount, to purchase an alternative
11 product.

12 **Claim 1:**

13 A method for using a smart card in a marketing analysis program designed
14 to introduce new products, the method comprising the steps of:

15 storing product information on the smart card when said products
16 are purchased by a consumer wherein said information including type,
17 quantity and dates of the product purchased;

18 identifying for each product a threshold for each of said type,
19 quantity and dates of products purchased;

20 determining an incentive for an alternative product based on said
21 threshold; and

22 automatically notifying said consumer when said threshold is
23 reached for a given product identified on the smart card and providing the
24 consumer with said incentive, whereby the incentive encourages the
25 consumer to consider alternative products.

b. Evidence

Reference A discloses smart card that tracks consumer preferences by
recording the type, quantity, and dates of purchase of pre-selected products to
determine trends in consumer purchases. The smart card is periodically read by a
scanner to determine its contents for market analysis. In return for using the smart
card and participating in the marketing program, the user is provided with free
product coupons for products that are normally purchased by the shopper.

Reference B discloses a traditional consumer incentive program that
provides coupons for the purchase of named products based upon the consumer's
purchase of those same products to promote customer loyalty.

1 c. Poor statement of the rejection

2 Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over
3 Reference A in view of Reference B. Reference A discloses the
4 conventional use of a smart card to track consumer preferences and provide
5 incentives. However, Reference A does not disclose the automatic
6 notification to consumer providing incentives. Reference B discloses
7 providing incentives to consumers to purchase the desired products. *It*
8 *would have been obvious to combine Reference A's smart card with*
9 *Reference B's incentive to consumers because the combination would*
10 *allow Reference A's smart card to be more efficient.*

11 d. Analysis

12 *The motivation, improve efficiency, is too general because it could cover*
13 *almost any alteration contemplated of Reference A and does not address why*
14 *this specific proposed modification would have been obvious.* Additionally,
15 there is nothing in either of references that would suggest automatically notifying
16 the consumer when reaching a threshold nor is there anything in either reference
17 that would suggest the notifying step. Finally, although Reference B teaches a
18 traditional coupon scheme to promote customer loyalty, there is no suggestion,
19 other than applicant's disclosure, to employ this scheme to promote the
20 introduction of new and alternative products. **The rejection is improper.**

21 In this example, as in the present case, the rejection provides a reason for
22 combining the references which is simply too general, and does not address *why* a
23 specific proposed modification would have been obvious. As noted in the critique
24 of Example 17, "[t]he motivation, improve efficiency, is too general because it
25 could cover almost any alteration contemplated of Reference A and does not
26 address why this specific proposed modification would have been obvious."

27 The present rejection is no different in spirit than the faulty rejection of this
28 example. As such, the Office has failed to establish a *prima facie* case of
29 obviousness and Applicant need not address the substance of the rejections.

1 **Claims 2-11** depend from claim 1 and are allowable as depending from an
2 allowable base claim.

3 **Claim 12** recites a storage medium comprising a plurality of executable
4 instructions which, when executed, implement an application program interface
5 (API) to dynamically generate one or more filter control command data structures
6 in response to a command received from a decoder application, wherein the one or
7 more filter control command data structure(s) include one or more parameters
8 which, when received by a communicatively coupled accelerator, effect one or
9 more filter settings on the accelerator in accordance with the received command.

10 In making out the rejection of this claim, the Office uses the same argument
11 and reasoning as it did in making out the rejection of claim 1. As noted above, the
12 Office has failed to establish a *prima facie* case of obviousness. As such, this
13 claim is allowable.

14 **Claims 13-17** depend from claim 12 and are allowable as depending from
15 an allowable base claim.

16 **Claim 18** recites a computing system comprising:

- 17
- 18 • a decoder application to process received media content; and
 - 19 • an operating system including an application program interface
20 (API), support the media processing, wherein the API generates one
21 or more filter control commands including one or more parameters
22 which, when received by a communicatively coupled media
23 processing accelerator, effect one or more filter settings of the
24 accelerator in accordance with a command received from the
25 decoder.

26 In making out the rejection of this claim, the Office uses the same argument
27 and reasoning as it did in making out the rejection of claim 1. As noted above, the

1 Office has failed to establish a *prima facie* case of obviousness. As such, this
2 claim is allowable.

3 Claims 19-25 depend from claim 18 and are allowable as depending from
4 an allowable base claim.

5
6 **Conclusion**

7 All of the claims are in condition for allowance. Accordingly, Applicant
8 requests a Notice of Allowability be issued forthwith. If the Office's next
9 anticipated action is to be anything other than issuance of a Notice of Allowability,
10 Applicant respectfully requests a telephone call for the purpose of discussing an
11 appeal.

12 Respectfully Submitted,

13
14 Dated: 10/7/04

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